

ESTTA Tracking number: **ESTTA399281**

Filing date: **03/22/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91184529
Party	Defendant Global Tissue Group, Inc.
Correspondence Address	R. GLENN SCHROEDER HOFFMAN & BARON, LLP 6900 JERICO TURNPIKE SYOSSET, NY 11791 UNITED STATES gschroeder@hoffmannbaron.com
Submission	Opposition/Response to Motion
Filer's Name	R. Glenn Schroeder
Filer's e-mail	rgsdocket@hoffmannbaron.com
Signature	/r. glenn schroeder/
Date	03/22/2011
Attachments	Redacted Applicants Opp. to Opposers Motion to Strike Witness Decs.pdf (11 pages)(624777 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

_____)	
GEORGIA-PACIFIC CONSUMER)	
PRODUCTS LP,)	
)	
Opposer,)	Opposition No.: 91184529
)	
v.)	
)	
GLOBAL TISSUE GROUP, INC.)	
)	
Applicant.)	
_____)	

**APPLICANT’S OPPOSITION TO OPPOSER’S
MOTION TO STRIKE WITNESS DECLARATIONS**

Applicant Global Tissue Group (“Global Tissue”) hereby submits this Opposition paper in response to Georgia-Pacific Consumer Products LP’s (“Georgia-Pacific”) Motion to Strike Witness Declarations.

I. INTRODUCTION

A. Background

After the close of discovery, and prior to the scheduled testimony period, Georgia-Pacific filed its Motion for Summary Judgment directed to the issue of whether Global Tissue had a *bona fide* intent to use the QUILTY mark at the time it filed its application. Although this issue could have been addressed in the final brief following the testimony period, Georgia-Pacific made a strategic decision to address this issue at this point in the proceeding by way of a Summary Judgment Motion.

Just prior to the filing of its Summary Judgment Motion, Georgia-Pacific filed a Motion for Leave to Introduce Expert Testimony. This Motion was opposed by Global Tissue, and fully briefed by the parties. Following a telephone conference, the Board granted

Georgia-Pacific's Motion for Leave to Introduce Expert Testimony in this proceeding. The Board noted in its Order that it would reopen discovery if and when proceedings were resumed to allow for the introduction of the expert testimony. In fact, one of Georgia-Pacific's main arguments in these earlier motion papers was that Global Tissue would not be prejudiced by the introduction of expert testimony because the trial period had not begun, and the Board could simply reopen the discovery period to provide for any necessary discovery.

In response to Georgia-Pacific's Motion for Summary Judgment, Global Tissue filed its Opposition paper dated February 10, 2011, together with three Declarations of three Global Tissue officers. Because Georgia-Pacific's Motion was filed prior to the testimony period, Global Tissue was forced to introduce by way of Declaration at least some of the evidence it would have otherwise introduced during the testimony period.

After receiving Global Tissue's opposition paper, Georgia-Pacific filed its Reply, together with its Motion to Strike the Witness Declarations. The very fact that Georgia-Pacific deems it necessary to attempt to Strike the Witness Declarations is a clear indication that the evidence in the Declarations not only raises a genuine issue of material fact, but actually establishes Global Tissue's *bona fide* intent to use the QUILTY mark.

B. Georgia-Pacific's Reply Acknowledges that Genuine Issues of Material Fact Exist

Because Georgia-Pacific has intertwined the arguments made in its Reply with the arguments set forth in its Motion to Strike, Global Tissue feels compelled to respond to the new points set forth in its Reply. Georgia-Pacific argues in its reply paper that it is entitled to Summary Judgment because Global Tissue's evidence is 1) self-serving; 2) uncorroborated; 3) subjective; 4) contradicts prior deposition testimony; and 5) provides new information not previously disclosed in discovery.

Georgia-Pacific's argument that the Declarations are self-serving should be dismissed on its face. The Declarations set forth the factual background concerning the selection of the QUILTY mark. The fact that the evidence set forth in such Declarations demonstrates Global Tissue's *bona fide* intent to use the mark does not make such Declarations self-

serving – it merely makes the evidence something that Georgia-Pacific does not want to address.

Georgia-Pacific's argument that the Declarations are uncorroborated is not understood. Even the Declaration of a single witness can introduce an issue of material fact into a Summary Judgment proceeding. Here, however, the introduction of three separate Declarations from three separate officers of Global Tissue clearly provides corroboration in that each Declarant confirms the statements made by the other Declarants, as well as the earlier deposition testimony. In addition, the recently-produced emails corroborate the statements in the Declarations.

Georgia-Pacific's argument that the evidence and Declarations are subjective is also not understood. The Declarations set forth the factual background concerning the selection of the QUILTY mark. Each Declarant has, to his best recollection, set forth a statement of facts. Georgia-Pacific is free to challenge that statement of facts – but there is nothing subjective about the Declarations.

Georgia-Pacific's argument that the Declarations contradict prior deposition testimony is contrary to the facts and to the actual testimony. Georgia-Pacific argues that the Declarations are inconsistent with sworn statements Global Tissue made during discovery. It cites four specific examples where it argues that the Declarations contradict prior sworn statements. However, each of these examples, when considered beyond Georgia-Pacific's selective quotation of the transcript, is unfounded.

The first example cited by Georgia-Pacific concerns alternative brand names. In this regard, Mr. Shaoul was asked rather vague questions which the transcript makes clear that he did not fully understand. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

The second example cited by Georgia-Pacific is directed to whether Mr. Shaoul was the sole person involved in the selection and adoption of the QUILTY mark. [REDACTED]

[REDACTED]

The third example cited by Georgia-Pacific is directed to the recently-produced emails. [REDACTED]

[REDACTED]

The fourth and final example cited by Georgia-Pacific is directed to the types of products in which the QUILTY mark will be used. [REDACTED]

[REDACTED]

Georgia-Pacific notes at Page 7 of its Reply that:

Even assuming the witness declarations are credible and admissible evidence, they only establish that (i) GTG decided to develop a new brand name that it intended to use for its premium paper products; (ii) individuals with the company discussed and selected the QUILTY mark for these products; and (iii) it filed a trademark application for QUILTY mark.

In other words, Georgia-Pacific is acknowledging that the Declarations establish that Global Tissue decided to develop a new brand name that it intended to use for its premium paper products, and that individuals with the company discussed and selected the QUILTY mark for these products. Although Georgia-Pacific argues otherwise, it is clear that the first two steps alone are sufficient to establish a *bona fide* intent to use a mark. Georgia-Pacific cites the non-precedential *SmithKline Beechum* case to support its argument that the three steps mentioned above do not support a finding of a *bona fide* intent to use a mark. However, the *SmithKline Beechum* case addressed only the third step, i.e., that the mere filing of a trademark application does not establish a *bona fide* intent to use the mark. The first two steps were not discussed or considered by the TTAB in *SmithKline Beechum*. In fact, a reading of that case would suggest that if the Applicant had been able to establish the first two steps, that it would have been successful in establishing a *bona fide* intent to use the mark. The facts are even more compelling in the present proceeding in that Global Tissue is in the business of manufacturing the very same products recited in the opposed application.

Georgia-Pacific also cites the Board's decision in *L.C. Licensing, Inc. v. Berman*, 86 U.S.P.Q. 2d 1883 (TTAB 2008). Georgia-Pacific argues that the "opposer moved for summary judgment based in part on an assertion that applicant lacked a *bona fide* intent to use the mark." It is not clear whether Georgia-Pacific is intentionally trying to mislead this Board, or merely misinterpreted the facts of this case, because the decision in *L.C. Licensing* was reached following the completion of the testimony period, and the filing of Briefs – not following the filing of a Summary Judgment Motion. As such, any discussion of the facts of the *L.C. Licensing* case is simply not relevant in that the testimony period has not yet started

in the present proceeding, and the Board has already indicated that discovery will be extended when proceedings are resumed.

Finally, Georgia-Pacific argues in its reply that GTG made the assertion “that it has no corroborating evidence because it wanted to see what happened in this Board proceeding.” No such statement was ever made by Global Tissue.

In sum, Georgia-Pacific’s Reply not only fails to support its Motion for Summary Judgment, but actually highlights the factual issues in dispute in this proceeding.

II. ARGUMENT

A. The Filed Declarations are Proper and Consistent with Prior Testimony

Georgia-Pacific repeatedly attempts throughout its papers to confuse the issues of documentary evidence and oral evidence, as well as the timing for introducing a party’s evidence. It argues in its Motion to Strike that the “Board should strike the Declarations of Mr. Shaoul, Mr. Elnekaveh and Mr. David because they contain new information and documents that GTG repeatedly refused to disclose during the discovery period.” This statement essentially summarizes Georgia-Pacific’s entire argument in its Motion to Strike.

Turning first to the assertion that the Declarations contain new information, Global Tissue notes that the Summary Judgment Motion on this issue was filed prior to the testimony period, and thus the only way in which Global Tissue could introduce evidence on this issue was by way of Declaration. Accordingly, unless Georgia-Pacific is arguing that a party should be precluded from introducing its own testimony on a particular issue whenever a Summary Judgment Motion is brought, then the Board will certainly recognize that a Declaration accompanying a response to a Summary Judgment Motion may contain new information.

Next, Georgia-Pacific argues that Global Tissue repeatedly refused to disclose the documents attached to the Declarations during the discovery period. This statement is rather misleading. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]. Second, Georgia-Pacific should recall how earlier in this proceeding when compelled by the Board to produce search reports, it repeatedly advised Global Tissue that no such search reports existed until about a week before the deposition of its in-house counsel, at which time hundreds and hundreds of pages of search reports were uncovered in Georgia-Pacific's possession and produced to Global Tissue.

Finally, as to the response to Interrogatory No. 3, [REDACTED]

In sum, the evidence set forth in the filed Declarations is proper and consistent with the prior testimony, and the production of the privileged emails to corroborate the evidence contained in such Declarations is in no way prejudicial to Georgia-Pacific.

B. Mr. Elnekaveh's Declaration is Consistent with his Prior Testimony

Georgia-Pacific argues that Global Tissue never disclosed that Mr. Elnekaveh had any knowledge of its selection and adoption of the QUILTY mark. Georgia-Pacific states that it deposed Mr. Elnekaveh who testified that he was not involved in the selection of the QUILTY mark. That testimony is and remains true. In his Declaration, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

C. Georgia-Pacific's Arguments Concerning Exclusion of Evidence are Misplaced

Georgia-Pacific argues at great length in its paper that evidence not produced during discovery should be excluded. They cite numerous cases wherein certain evidence not produced during discovery was subsequently excluded from consideration. However, what it fails to mention to the TTAB, or to discuss in its paper, is that all of these cited cases concern proceedings which included a testimony period. In other words, once parties begin a testimony period, and after the Opposer has presented its case in chief, it would be unfair to allow an Applicant to then introduce new evidence into the proceeding. However, that is not the case at hand. Here, the testimony period has not yet begun.

As for the recently produced privileged emails, Georgia-Pacific should remember that it sought and was granted leave to introduce expert testimony into this proceeding one year after the deadline for doing so had expired, and only 6 days prior to the close of discovery. Georgia-Pacific should also recall that it produced documents on the last day of discovery that it had in its possession for almost 2 years. However, the real point to consider is that the

Board has already indicated that discovery will be extended once these proceedings are resumed. Thus, any issues dealing with potential prejudice concerning recently produced documents can be addressed through limited follow-up discovery.

D. Mr. David's Declaration is Proper and Appropriate, and Should Not be Excluded

Of all of its arguments contained in both its Summary Judgment and Motion to Strike papers, the argument to exclude Mr. David's Declaration may be the most creative. In particular, Georgia-Pacific asks the Board to strike the Declaration because Global Tissue failed to identify him as a witness with knowledge during discovery. Contrary to Georgia-Pacific's argument, there was no obligation to identify Mr. David as a witness in Global Tissue's interrogatory responses. Moreover, Rule 26(a) only requires a party to disclose individuals that it "may use to support its claims to defenses." Obviously at the time Global Tissue prepared its initial disclosures, it was unaware that Georgia-Pacific would be filing the present Summary Judgment Motion.

Georgia-Pacific then cites the TTAB's decision in *Jules Jurgensen-Rhapsody, Inc. v. Baumberger*, 91 U.S.P.Q. 2d 1443 (TTAB 2003). The parenthetical following the citation of this case notes that a Motion to Strike was granted when the witness was "not disclosed in petitioners initial disclosures." However, that parenthetical is extremely misleading. The basis for the Board's decision to strike the testimony of the witness was that the party had failed to identify such witness "no later than fifteen days prior to the opening of [the] testimony" in accordance with Trademark Rule 2.121(e). In other words, the *Baumberger* decision concerned a witness produced during the testimony period who had not been disclosed in accordance with the Board's new pretrial disclosure rules. The case had nothing to do with initial disclosures, and Georgia-Pacific citation of the case for that point is improper.

Here, there has been no testimony period and the originally scheduled time for Global Tissue to identify its trial witnesses was never reached due to the filing of Georgia-Pacific's Summary Judgment Motion. For Georgia-Pacific to argue that somehow Global Tissue had


an obligation to identify its witnesses prior to the time period for doing so and/or in response to a Motion it did not know would be brought by Georgia-Pacific, is meritless.

III. CONCLUSION

In view of the arguments set forth hereinabove, together with the evidence set forth in the attached supplemental Declaration of Philip Shaoul, there can be no doubt but that the earlier-filed Declarations are proper and that the evidence in such Declaration is not only sufficient to raise genuine issues of material fact precluding the finding of Summary Judgment, but actually establish Global Tissue's *bona fide* intent to use the QUILTY mark. Accordingly, both Georgia-Pacific's Motion to Strike the Declarations, as well as its Motion for Summary Judgment, should be denied.

Dated: March 22, 2011

Respectfully submitted,



Charles R. Hoffmann
R. Glenn Schroeder

Hoffmann & Baron, LLP
6900 Jericho Turnpike
Syosset, New York 11791
Telephone: (516) 822-3550
Facsimile: (516) 822-3582
choffmann@hoffmannbaron.com
gschroeder@hoffmannbaron.com
Attorneys for Applicant
Global Tissue Group, Inc

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this date, March 22, 2011, a copy of the foregoing APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO STRIKE WITNESS DECLARATIONS was served upon the Opposer, by email and by U.S. mail, to Opposer's current identified counsel, as set forth below:

Charlene R. Marino, Esq.
Kilpatrick Stockton, LLP
1100 Peachtree Street, Suite 2800
Atlanta, Georgia 30309
cmarino@kilpatrickstockton.com

A handwritten signature in dark ink, appearing to read 'R. Glenn Schroeder', is written over a horizontal line.

R. Glenn Schroeder